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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,013	10/04/1999	Jonas Lowell Steinman	10153-003	9120

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EXAMINER	
ALVAREZ, RAQUEL	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/412,013	STEINMAN ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *9/22/2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-16, 19-34, 36-51 and 71-81* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-16, 19, 34, 36-51 and 71-81* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This action is in response to communication filed on 3/27/2003. Claim 2-16, 19-34, 36-51 and 71-81 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 2, 16, 19, 33, 36, 50, 52, 71, 74, 76 and 81, are rejected under 35 U.S.C. 102(a) as being anticipated by article by Marc Gunther titled "The trouble with advertising" hereinafter Gunther.

With respect to claims 76, 2, 16, 71, 19, 33, 81, 36, 50, 52, 74, 79, Gunther teaches a sweepstake system (page 1, paragraph IV). A host system computer system hosting a webpage, wherein the webpage includes a plurality of links and each of the plurality of links has an associated point value associated with the one of the plurality of hyperlinks(i.e. An avid sports fan or anyone with nothing better to do can click on enough links to earn points)(page 1, paragraph IV); wherein the host computer system awards at least one point to a user as a result of the user clicking on the one of the plurality of hyperlinks and wherein the user is given a number of at least one entry in a sweepstakes based on a number of points the user has been awarded for clicking on the one of the plurality of hyperlinks (i.e. the user can exchange earned points for $1 million cash prize entries to a sweepstakes).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 3-15, 20-32, 34, 37-49, 51, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunther.

Claims 3, 13, 20, 30, 37, 47, further recite storing registration information pertaining to the user, such as point information relating to the user. Official notice is taken that it is old and well known to store information in a database or the like for easier retrieval and access of the data. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included storing registration information or point information related to the user because such a modification would allow the system to keep user's information within easy access.

Claims 4-7, 9-12, 14-15, 21-24, 26-29, 31-32, 38-46, 48-49, 51, 55-56, 72, 73, 75, 77-78 and 80 are different implementation choices that can be implemented without major changes to the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included implementing the system as recited by claims 4-7, 9-12, 14-15, 21-24, 26-29, 31-32, 38-46, 48-49, 51, 55-56, 64-66, 68-69 as designer's choices.

Claims 34 and 70 are similar in scope as claims 16, 33 rejected above and therefore rejected under similar rationale.

With respect to claims 8 and 25, Gunther do not specifically teach that one of the services is e-mail. E-mail is a common service offered in the on-line world. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included e-mail as one of the services offered.

Response to Arguments

4. The Applicant argues that Sp7ortline doesn't award points for clicking. The Examiner disagrees with Applicant because in Sportline the user receives points as a result of the user clicking on the hyperlink to view the page. The clicking on the page will have to occur in order for the users to be awarded the points.

5. With respect to Applicant's argument that the Sportline reference cannot award points to the user for merely clicking on a hyperlink . The Applicant is reminded that disclosed examples and preferred embodiments do not constitute a **teaching away from a broader disclosure** *In re Susi,* 169 USPQ 423 (CCPA 1971).

6. With respect to Applicant's argument that the Sportline reference doesn't teach directing the user to a third-party website. The examiner disagrees with Applicant because the Sportline reference teaches that the sites such as Sporline, MSNBC and Yahoo are trying to spike traffic to their site by marketing and promoting other products through their site such as banner ads in order to generate traffic for other sites and to charge those sites for directing the users to their ads (page 1, paragraph IV, page 2, paragraph I-V and page 3) .

7. With respect to Applicant's arguments with respect to the official notice taken that a database to store information on the users such as registration information for the users it is old and well known such as a college registrar wherein all the registration information for the students are stored in a database for easy access and retrieval. The examiner wants to point out to *In re Sheckler*, 168 USPQ 716 (CCPA 1971) which states that it is not necessary that a reference actually suggest changes or possible improvements which applicant made. *In re Fine,* 5 USPQ2d 1596 (CA FC 1988)The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." Also in *In re Bozek*, 163 USPQ 545 (CCPA 1969)"Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"

8. With respect to the arguments pertaining to claims 4-7, 9-12, 14-15, 21-24, 26-29, 31-32, 38-46, 48-49, 51, 55-56, 64-6 and 68-69, the Examiner wants to point out that the features claimed are common knowledge and common sense choices which can be implemented without undue experimentation when running any awards or sweepstakes programs.

9. With respect to Applicant's arguments with respect to claims 8 and 25, the Examiner wants to point out that one skilled in the art is presumed to have general knowledge in the art such as providing one of the service to be offered to be e-mail.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Raquel Alvarez
Examiner
Art Unit 3622

R.A.
11/4/03

ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600